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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,736	02/28/2000	Claudine Kam	SMTTC-01001US0WSW/PPT	8641

7590 01/14/2003
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EXAMINER

BUI, THACH H

ART UNIT PAPER NUMBER

3628

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,736

Applicant(s)

KAM ET AL.

Examiner

Thach H Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1-12 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompasses any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 1-12 also does not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1-12 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim(s) are narrative in form and replete with indefinite and functional or operational language and it is too numerous to mention specifically. *The following informalities are merely exemplary thereof.* The structure must be organized and correlate in such a manner as to present a complete operative device. Applicant merely describes various desired results of the claimed invention. The claimed parts and the various functions render the claim(s) vague and indefinite since they are not explicitly set forth and presented a complete set of discrete steps.

The Examiner suggests that if a method claim(s) is/are to be recited, a series of discrete steps defining the intended result set forth in the preamble should be positively recited. If an apparatus claim is to be recited, enough structure for enabling the claimed invention should be recited. Furthermore, the Examiner cannot determine where the inventive concept lies, and cannot apply art rejections.

Claim 1 is vague and indefinite because "excluding a portion of the accesses information from subsequent data manipulation; and generating tabulated data from the un-excluded data in the accessed information through data manipulation" renders the

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claim unclear. There is no clear definition for both excluded and un-excluded data in the accessed information through data manipulation. What is included and excluded?

Claim 2 is vague and indefinite because "the step of excluding also includes the step" renders the claim unclear.

Claim 2 is vague and indefinite because "the step of generating is based on at least a user-preference" renders the claim unclear. Is it the same as the means for generating tabulated data recited in claim 1? If not, what is being generated?

Claim 3 is vague and indefinite because "the method further comprises the step of comparing tabulated data from wholesale billing data with the reseller's internal billing information for correctly billing the customer" renders the claim unclear (idiomatic English).

Regarding claim 5, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Claim 6 is vague and indefinite because there is no clear or proper antecedent basis for "the step of comparing". What is the step of comparing?

Claim 7 is vague and indefinite because there is no clear or proper antecedent basis for "the steps of accessing, excluding, and generating"

Claim 10 is vague and indefinite because "the step of repeating from the step of accessing after the step of generating. ...very small part" renders the claim unclear.

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Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rome et al., Reifer et al., Carpenter, Golden et al., Cross, Malik, Mashinsky, Smith, and Hayes are cited of general interest.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thach H Bui whose telephone number is 703-305-0063. The examiner can normally be reached on Monday-Friday, 7:30-4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

T.B.
December 30, 2002


Hyung S. Sough
Primary Examiner